

REMARKS

The present application relates to hybrid maize plant and seed 33T17. Claims 1-42 are currently pending in the present application. Applicant respectfully requests consideration of the following remarks.

Detailed Action

A. Deposit Statement

Applicant submits the Deposit section has been amended in order to properly include both the hybrid maize plant 33T17 and the inbred parents GE515488 and GE534625 within the deposit paragraph on page 40. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. Applicant further asserts that the deposits have been made without restriction. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and
- e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 33T17 and the inbred parents GE515488 and GE534625 have been deposited with the ATCC. The specification has now been amended to correct these minor changes. Applicant requests reconsideration.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 9-11, 13-19, 22-24 and 26-32 remain rejected and 39 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record set forth in the Office Action mailed September 11, 2002.

Claims 9, 13, 17, 22, 26 and 30 remain indefinite because the claims do not set forth any positive method steps leading to the maize plant at line 1 of the claims. The Examiner states it is unclear what the metes and bounds of the claimed methods are.

Applicant has canceled claims 9, 13, 17, 22, 26, and 30, thus alleviating this rejection.

The Examiner rejects claims 10, 14, 18, 21, 27 and 31 as being indefinite for being dependent upon an indefinite claim. The Examiner states the limitations within said claims do not obviate the indefiniteness of the claim upon which they depend.

Applicant has canceled claims 10, 14, 18, 21, 27 and 31, thereby alleviating this rejection.

Claims 11, 15, 19, 24, 28 and 32 remain indefinite because the phrases "yield ability", "food grade quality" and "test weight", for example, are relative and do not state the metes and bounds of the claimed invention.

Applicant has canceled claims 11, 15, 19, 24, 28 and 32, alleviating this rejection.

The Examiner rejects claims 16 and 29 as indefinite because it is unclear how one skilled in the art could produce the maize plant of claim 2 or 20 containing one or more genes transferred by backcrossing. The Examiner further states it is unclear what the metes and bounds of these claims are.

Applicant has canceled claims 16 and 29, thus alleviating this rejection.

Claim 39 stands rejected as indefinite as being directed to a 33T17 maize plant said plant being produced by a method wherein the exemplified 33T17 maize plant is crossed with a second plant.

Applicant has canceled claim 39, thereby alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 9-19 and 22-32 remain rejected and claims 35-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed September 11, 2002. The Examiner previously stated the claims are broadly drawn to corn progeny plants and transgenic corn plants having undisclosed identifying characteristics whereby only the characteristics of the deposited corn line "33T17" are known. The Examiner states that over an undetermined number of generations, the identifying characteristics of each generation become highly unpredictable, especially in view of the fact that none of the identifying characteristics of the progeny plants are disclosed in the specification. Therefore the Examiner states there is a lack of adequate description of the claimed progeny plants, in view of the of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that Applicant was in possession of the claimed invention at the time of filing.

Applicant has cancelled claims 9-19, 22-32, and 35-40, thus alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration withdrawn of the rejections to claims 9-19, 22-32 and 35-40 under 35 U.S.C. § 112, first paragraph.

Issues Under 35 U.S.C. § 102/103

Claims 11, 15, 19, 24, 28 and 32 remain rejected and claims 39 and 40 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cunningham (U.S. Patent No. 6,087,564). The Examiner asserts this rejection is repeated for the reason of record as set forth in the last Office Action mailed September 11, 2002.

Applicant has canceled claims 11, 15, 19, 24, 28, 32 and claims 39 and 40, thereby alleviating this rejection.

In light of the above, Applicant respectfully requests the Examiner withdraw the rejection under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cunningham (U.S. Patent No. 6,087,564).

Summary

Applicant acknowledges that claims 1-8, 20, 21, 33, 34, 41 and 42 are allowed.

Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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